

AF/ [signature]  
JFW

**PATENT**  
Attorney Docket No. 188125

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

TANAKA et al.

Art Unit: 3622

Application No. 09/209,454

Examiner: D. Lastra

Filed: December 11, 1998

For: **SYSTEM FOR SELLING  
CONTACT LENS**

**TRANSMITTAL OF  
APPELLANTS' REPLY BRIEF**

U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Appeal Brief - Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Dear Sir:

In accordance with 37 CFR 41.41, appellants hereby submit Appellants' Reply Brief.

The items checked below are appropriate:

**1. Status of Appellants**

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

**2. Oral Hearing**

☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

☐ Appellants requested an oral hearing in accordance with 37 CFR 41.47 at the time appellants filed Appellants' Brief on Appeal.

**3. Extension of Time**

☐ Appellant petitions for a one-month extension of time under 37 CFR 1.136, the fee for which is \$ 0.00.

☒ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

**Extension fee due with this request: \$**

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**4. Total Fee Due**

The total fee due is:

Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 0.00

**Total Fee Due: \$**

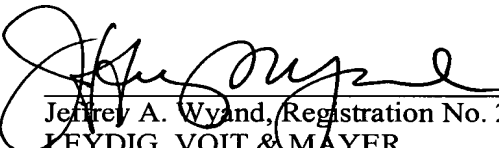
**5. Fee Payment**

- ☐ Attached is a check in the sum of \$ .  
☐ Charge Account No. 12-1216 the sum of \$ . A duplicate of this transmittal is attached.

**6. Fee Deficiency**

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,

  
Jeffrey A. Wyand, Registration No. 29,458  
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Date: August 4, 2005  
JAW:ves



PATENT  
Attorney Docket No. 188125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

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LENS

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Dear Sir:

In response to the Examiner's Answer mailed June 6, 2005, Appellants reply to four issues newly raised in the Examiner's Answer.

Claims 17, 19, and 21 were rejected over a combination of patents to Pauly, Fay, and Eberhardt. Claims 20 and 22 were similarly rejected, but with the addition of a non-patent publication.

In responding to the Argument presented in the Brief that the invention, unlike Pauly, avoids a confining doctor-patient relationship, the Examiner explained at page 12 of the Answer his application of Pauly. The Examiner acknowledged that "Pauly does not mention that medical records or prescription data of said patient can only be accessed by said doctor ...". The explanation that follows shows that the Examiner relied upon the absence of that disclosure in Pauly to assert that the arrangement of the claimed invention would have been an obvious combination of Pauly, Eberhardt, and Fay.

Prior art rejections are properly based upon disclosures in sources of prior art, not silence in those sources of prior art. Clearly, no suggestion for modification of the references can be derived from the silence of Pauly. Silence cannot point from Pauly toward the claimed invention. Thus, only if Pauly were modified by the disclosure of the invention itself could obviousness be established. Of course, the disclosure of an

invention cannot be used as prior art against the disclosure. Accordingly, the concession in the Answer shows that the basis of the rejection is prohibited hindsight reconstruction of the invention, based upon the disclosure of the patent application. Therefore, the rejection based on Pauly cannot be sustained.

As part of the rationale for the rejection appearing in the paragraph bridging pages 12 and 13 of the Answer, the Examiner suggests that the use of a portable recording medium carrying diagnostic information would have been obvious in the art “for the purpose of ordering contact lens products, even when said customer is very ill, unconscious, unable to speak, ignorant about his or her medical history or lack of mental or education capacity to retain or understand information given to them.” It is respectfully suggested that many of the people in this group are not in need of contact lenses and for the others a portable recording medium would be inadequate without supplementation by a personal caregiver. In terms of the rejection, the cited passage of Eberhardt simply does not provide basis for the hypothetical combination of sources of prior art to suggest the invention.


Fay relates to the selling of frames for eyeglasses and other “head-related products”. Appellants pointed out that there was no medical aspect in the selling of these products and the Examiner has responded, at page 15 of the Answer, that Fay describes supplying not only frames for eyeglasses but also prescription lenses, allegedly indicating medical involvement in the system described by Fay. However, Fay only describes the function of an optician in supplying prescription lenses that have been prescribed elsewhere by a medical practitioner and that are manufactured elsewhere. Fay describes a merchandizing system, not a system that relates to medical services. Thus, Fay does not suggest modification of the other references to produce the invention.

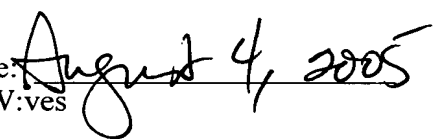
Finally, at page 16 of the Answer, the Examiner insists that the argument presented in the final paragraph at page 8 of the Brief concerning claim 19 is inconsistent with the language of that claim 19. Because of an inadvertent typographical error in the second line of that paragraph, the Examiner’s comment, to the extent of the inconsistency, is correct. Appellants respectfully request that the word “regular” appearing in the second line of that final paragraph on page 8 of the Brief be corrected to “irregular” so that the word conforms to the language of claim 19 as intended. The argument presented in that paragraph with regard to the claim 19 that is on appeal is otherwise correct, pertains to the correct language of claim 19, and is maintained by the Appellants.

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Appellants again request, based upon the arguments presented with regard to claims 17 and 19, that the rejections of claims 17-22 be reversed.

Respectfully submitted,

  
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